

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Sim-1

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on _____

Signature _____

Typed or printed name _____

Application Number

10/534,550

Filed

5-9-2005

First Named Inventor

Lee Simon

Art Unit

3637

Examiner

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

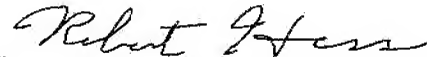
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
 (Form PTO/SB/96)

☒ attorney or agent of record.
 Registration number 32,139
☐ attorney or agent acting under 37 CFR 1.34.
 Registration number if acting under 37 CFR 1.34 _____



Signature

Robert J. Hess

Typed or printed name

203 356-0727

Telephone number

October 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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CLEAR ERRORS IN THE EXAMINER'S REJECTIONS

Failure to identify counterparts in the cited prior art -- MPEP 706.02(j)(A)-(D) or MPEP 707(b)(2) non-compliance

A clear error lies in the failure to identify where there is a counterpart in the VentMaster's MDS to the recitation of independent claim 1 regarding "the utility chassis including a plurality of clusters each with different types of connectors suited to provide access to utilities, the different types of connectors being in relative positions within associated ones of the clusters in a manner that is identical for each of the clusters".

As a result, the claim rejection of the final Office Action of April 10, 2007 is not in compliance with MPEP 706.02(j)(A)-(D) or MPEP 707(b)(2) as concerns describing how VentMaster's MDS fits into substantiating the claim rejection based on obviousness. Page 4 of the final Office Action simply copies claim language from claim 1 and asserts that VentMaster's MDS teaches that "idea" (Page 4 lines 9-14, 20 to page 5 line 3), but without identifying any location in VentMaster's MDS where the "idea" or recited subject matter is to be found in VentMaster's MDS.

Failure to Answer Rebuttal Arguments - MPEP 707.07(f) non-compliance

Indeed, neither the Advisory Action of July 11, 2007 nor that of September 13, 2007 even acknowledged, let alone rebutted, any substantive patentability argument presented in the amendments after final. When one considers that reliance on VentMaster's MDS was raised for the first time in the final Office Action as a basis to reject the claims and the Advisory Actions maintained the claim rejection despite the amendments filed after final rejection, the failure in the

Advisory Actions to make any answer on the merits to the arguments raised and thereby “take note of applicant’s argument and answer the substance of it” is contrary to MPEP 707.07(f). Under *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958), the Office Action’s lack of answering in rebuttal to applicant’s arguments compels acceptance of applicant’s statement of advantages at face value to find applicable claims allowable. See MPEP 707.07(f) and the Amendment dated July 23, 2007 at the bridging paragraph between pages 6 and 7 and at the bottom full paragraph of page 12.

Prolonged delay For Advisory Actions - MPEP 714.13 non-compliance

The Advisory Actions of July 11, 2007 and September 13, 2007 are not in compliance with MPEP 714.13 that provides:

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner.

Here, an Advisory Action of July 11, 2007 issued 41 days after an Amendment was forwarded to the Examiner on May 30, 2007 and the Advisory Action of September 13, 2007 issued 44 days after an amendment was forwarded to the examiner on July 31, 2007. In each case, the turnaround was well beyond the expected 10 days.

Neither Advisory Action, nor even the Examiner interviews on July 20, 2007 and on October 2, 2007, shed any light as to where the counterparts in VentMaster’s MDS can be found concerning the relative arrangement of utility connections being “identical” for each of the clusters.

THE EXAMINER'S OMISSIONS OF ONE OR MORE ESSENTIAL ELEMENTS NEEDED FOR A *PRIMA FACIE* REJECTION

Omission of Essential Element in Cited Prior Art

The recitation of independent claim 1 of “the utility chassis including a plurality of clusters each with different types of connectors suited to provide access to utilities, the different types of connectors being in relative positions within associated ones of the clusters in a manner that is identical for each of the clusters” constitutes an essential element of the claim language. To make out a prima facie rejection, a counterpart needs to be identified. Such was not done, beyond copying the claim language in the final Office Action and contenting that VentMaster’s MDS teaches the “idea”. The omission concerns the failure to identify exactly where in VentMaster’s MDS such a counterpart is to be found. See pages 10-12 of the Amendment dated July 23, 2007.

Omission of motivation for incorporating MDS raceway into frame receptacles

The examiner further failed to show proper motivation for making a modification in the obviousness rejection. VentMaster’s MDS does not reveal any frame receptacle for accommodating appliances – instead, a utility line raceway provides access to utilities, to which branch connections can be made to access utilities by appliances, such as those, for instance, within frame receptacles of Alden et al. and Wilkinson. See page 10 of the Amendment filed July 23, 2007 with respect to VentMaster’s MDS drawing with notes “Isolated plumbing chase” and “Branch plumbing connections with optional quick connect fittings and color – coded hoses”.

To make the utility line connections through a frame receptacle would require the expertise of a skilled tradesperson to reach the appliance. Such is avoided in accordance with the claimed invention by making provision for the recitation in claim 1 of “the different types of connectors being in relative positions within associated ones of the clusters in a manner that is identical for each of the clusters”. Unused utility connections remain available upon replacing one type of appliance for another within a compartment of the frame receptacle.

There is no showing of motivation to modify the frame receptacles of Alden et al. or Wilkinson, however, to actually incorporate inside the raceway of VentMaster’s MDS, even if VentMaster’s MDS shows “a practical, versatile and efficient way of distributing utilities, easily removed and modified to suit different arrangements of cooking equipment”. This is because VentMaster’s MDS serves as a utility line raceway with its own isolated plumbing chase inside.

Indeed, VentMaster’s MDS describes itself on its second page as “a custom built general utility center that provides distribution controls for as many foodservice equipment mechanical services as required.” “The system is easily moved and modified to suit different arrangements of cooking equipment”.

In contrast to VentMaster’s MDS, interchanging appliances of different kinds within the frame receptacle of the present invention does not require the chase to be “moved and modified to suit different arrangements of cooking equipment”.